

REMARKS/ARGUMENTS

Claims 1-13, 15-25 and 27-37 remain in the application for further prosecution. Claims 14 and 26 were previously cancelled. In response to the Final Office Action mailed April 21, 2009, please consider the following remarks rendered in **appeal brief format**. The Examiner is invited to telephone the undersigned if the below remarks do not result in allowance of the claims, to discuss whether any agreement can be reached with respect to the claims to expedite prosecution and to avoid an appeal.

1. REAL PARTY IN INTEREST

The real party in interest of the above-captioned patent application is the Assignee, WMS Gaming, Inc.

2. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellant that will have a bearing on the Board's decision in an appeal of this matter.

3. STATUS OF THE CLAIMS

Claims 1-13, 15-25 and 27-37 remain in the application. Claims 14 and 26 were canceled previously.

4. STATUS OF AMENDMENTS

No amendments have been made subsequent to the last amendment filed on January 13, 2009.

5. SUMMARY OF CLAIMED SUBJECT MATTER

Aspects of the present inventive subject matter include, but are not limited to, methods and systems for different game outcomes to achieve identical awards. The claimed subject matter is as follows:

1. A method for playing a wagering game having a special payout, the method comprising:

presenting a basic game having a plurality of randomly selected outcomes being selected independently of player selection, the randomly selected outcomes including a special-payout outcome;

accepting a basic wager from a player for the basic game between a minimum and maximum amount;

presenting an additional, separate side-wager option for a player to place an additional side-wager distinct from the accepted basic wager, the side-wager option requiring a side-wager amount in addition to the accepted basic wager;

in response to a player not choosing the side-wager option, providing the player with a first probability greater than zero of achieving the special-payout outcome;

in response to the player choosing the side-wager option, providing the player with a second probability of achieving the special-payout outcome, the second probability being greater than the first probability;

conducting the basic game with the first probability if the player does not choose the side-wager option, or the second probability if the player chooses the side-wager option; and

in response to conducting, crediting the player the special payout when the special-payout outcome occurs in the basic game.

10. A method for playing a wagering game on a gaming terminal, the wagering game having a progressive payout, the method comprising:

presenting a basic game having a plurality of randomly selected outcomes being selected independently of player selection, the randomly selected outcomes including a progressive-payout outcome;

accepting a basic wager from a player for the basic game between a minimum and maximum amount;

presenting an additional, separate side-wager option for a player to place an additional side wager distinct from the accepted basic wager, the side-wager option requiring a side-wager amount in addition to the accepted basic wager;

presenting a first spinning reel, the first spinning reel providing the player with a first probability greater than zero of achieving the progressive-payout outcome;

presenting a second spinning reel, the second spinning reel providing the player with a second probability of achieving the progressive-payout outcome, the second probability being greater than the first probability; and

in response to the player selecting the side-wager option, substituting the second spinning reel for the first spinning reel, increasing the player's probability of winning the progressive payout.

12. A gaming terminal for playing a wagering game having a special payout with a first payout and a second payout, the gaming terminal comprising

a basic game having a randomly selected outcome being selected independently of player selection;

a basic wager input accepting a basic wager from a player for the basic game on at least one of a plurality of paylines, the basic wager being between a minimum and maximum amount;

the gaming terminal having two options for being eligible for the special payout, the two options including (i) an additional, separate side-wager input option for placing an additional a side-wager distinct from the accepted basic wager, the side-wager option requiring a side-wager amount in addition to the accepted basic wager and (ii) a max-wager option for placing the basic wager at the maximum amount resulting in wagers on each of the plurality of paylines;

wherein, in response to selection of either of the two options, the gaming terminal awards the player the first payout when a first randomly selected outcome is achieved in the basic game and the gaming terminal awards the player the second payout when a second randomly selected outcome is achieved in the basic game; and

wherein if neither of the two options is selected, the gaming terminal does not award the player the first payout when the first randomly selected outcome is achieved in the basic game and does not award the player the second payout when the second selected outcome is achieved in the basic game.

25. A gaming terminal for playing a wagering game, comprising:

a basic game having a plurality of symbols that indicate a randomly selected outcome of the basic game, the randomly selected outcome being selected independently of player selection, the basic game also having a plurality of paylines;

a progressive payout having a first payout;

a basic wager input to accept a basic wager from a player for the basic game between a minimum and maximum amount, the maximum amount resulting in wagers applied to each of the plurality of paylines; and

a side-wager input device for allowing a player to place an additional, separate side-wager distinct from the accepted basic wager, the side-wager option requiring a side-wager amount in addition to the accepted basic wager;

wherein the gaming terminal presents the player with two independent options to be eligible for the progressive payout, the two independent options including (i) the player placing the side-wager via the side-wager input device and (ii) the player placing the maximum amount of the basic wager;

wherein, in response to either of the two options being chosen, the gaming terminal awards the player the first payout when a first randomly selected outcome is achieved and wherein if neither of the two options is chosen, the gaming terminal does not award the player the first payout when the first randomly selected outcome is achieved.

28. A method for playing a wagering game having a special payout, the method comprising:

conducting a basic game having a plurality of randomly selected outcomes selected independently of player selection;

accepting a basic wager from a player for the basic game between a minimum and maximum amount, the maximum amount resulting in a wager on each of a plurality of paylines;

presenting an additional, separate side-wager option for a player to place a side-wager distinct from the accepted basic wager, the side-wager option requiring a side-wager amount in addition to the accepted basic wager; and

in response to the player selecting either the side-wager option or the maximum amount of the basic wager, crediting the player the special payout when a special-payout outcome occurs in the basic game, and wherein if neither the side-wager option nor the maximum amount of the basic wager is selected, the gaming terminal does not credit the player the special payout when the special-payout outcome occurs in the basic game.

29. A gaming terminal for playing a wagering game having a special payout, the gaming terminal comprising:

a basic game having a plurality of randomly selected outcomes being selected independently of player selection, the randomly selected outcomes including a special-payout outcome that awards the special payout;

a basic wager input accepting a basic wager from a player for the basic game between a minimum and maximum amount;

a side-wager input device to accept an additional, separate side-wager distinct from the accepted basic wager, the side-wager option requiring a side-wager amount in addition to the accepted basic wager;

wherein in response to a player not making a side-wager distinct from the basic wager, the gaming terminal providing the player with a first probability greater than zero of achieving the special payout; and

in response to the player making a side-wager distinct from the basic wager, the gaming terminal providing the player with a second probability of achieving the special-payout outcome, the second probability being higher than the first probability, and the gaming terminal further crediting the player the special payout if the special-payout outcome occurs.

6. GROUND FOR REJECTION TO BE REVIEWED ON APPEAL

1. Whether the pending claims were properly rejected under either 35 U.S.C. 102(b) or 35 U.S.C. 103 based on Glavich.

The April 21, 2009 Final Office Action rejected Claims 1-2, 4-5, 7, 9, 29, 31-32, 34, and 36 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,309,300 ("Glavich"). Claims 3, 12-13, 15-16, 18, 23, 25, 27-28, 30, and 37 were rejected under 35 U.S.C. 103(a) as being unpatentable over Glavich. Claims 6, 17, and 33 were rejected under 35 U.S.C. 103(a) as being unpatentable over Glavich, in view of U.S. Patent No. 6,186,894 ("Mayeroff"). Claims 8, 10-11, and 35 were rejected under 35 U.S.C. 103(a) as being unpatentable over Glavich, in view of U.S. Publication No. 2004/0166918 ("Walker '918"). Claims 19-22 and 24 were rejected under 35 U.S.C. 103(a) as being unpatentable over Glavich, in view of U.S. Publication No. 2003/0064807 ("Walker '807").

7. ARGUMENT

There are fundamental differences between the claimed subject matter and Glavich that mandate that the pending claims are allowable over Glavich. The pending claims relate primarily to a method and gaming terminal for providing the player with multiple ways to achieve a special payout in a basic game. For example, claims 1, 10 and 29 present a basic game

having a plurality of randomly selected outcomes being selected independently of player selection, the randomly selected outcomes including a special-payout outcome. A basic wager is accepted from a player for the basic game between a minimum and maximum amount. An additional, separate side-wager option is presented for a player to place an additional side-wager distinct from the accepted basic wager. If the player does not choose the side-wager option the player is provided with a first probability greater than zero of achieving the special-payout outcome. If the player chooses the side-wager option, the player is provided with a second probability of achieving the special-payout outcome. The basic game is conducted with the first probability if the player does not choose the side-wager option, or the second probability if the player chooses the side-wager option. The player is credited with the special payout when the special-payout outcome occurs in the basic game.

Similarly, claims 12, 25 and 28 provide a player either a side-wager or a max-bet option that give the player the opportunity to win special payouts. If the player does not wager either the side wager or make a max-bet, the player is not eligible for the opportunity to win the special payouts.

Glavich relates to an entirely different type of game. Glavich discloses a wagering game with a main game 214 that provides bonus trigger event 216 that triggers a bonus game as shown in Fig. 2. (Col. 3, ll. 43-57). The bonusing features allow a player to select up to “Z” number of “N” number of selectable items. (Col. 3, ll. 58-65). A player may be given an option to increase N or Z for a side wager. (Col. 3, l. 65 – Col. 4, l. 7, Col. 4, ll. 33-40). Glavich allows another variable, M, which is the number of selectable items that actually have associated awards. (Col. 5, ll. 24-30). Thus, Glavich specifically notes that “there may be some selectable items which have no associated items (or, equivalently, which are associated with blank or zero-value

associated items) such that, upon selecting such a selectable item, there is no affect upon the total prize.” (Col. 5, ll. 18-23). Glavich does not disclose effecting outcomes in a basic game nor does Glavich disclose awarding a payout outcome. The missing elements between sample pending claims and Glavich may be shown in the tables below.

Claim Element	Glavich
1. (Currently Amended) A method for playing a wagering game having a special payout, the method comprising:	
presenting a basic game having a plurality of randomly selected outcomes being selected independently of player selection, the randomly selected outcomes including a special-payout outcome;	There are no special-payout outcomes in the Glavich basic game. The only “special outcome” is triggering the bonus game in Glavich which in of itself is not a payout. Glavich mandates that a player selects an outcome in the bonus game. That outcome is therefore not randomly selected
accepting a basic wager from a player for the basic game between a minimum and maximum amount;	
presenting an additional, separate side-wager option for a player to place an additional side-wager distinct from the accepted basic wager, the side-wager option requiring a side-wager amount in addition to the accepted basic wager	The side wager offer in Glavich occurs after the basic game outcome and therefore Glavich does not present a separate side-wager offer
in response to a player not choosing the side-wager option, providing the player with a first probability greater than zero of achieving the special-payout outcome;	Not choosing the side wager option in Glavich does not change the probability of the occurrence of the basic game outcome
in response to the player choosing the side-wager option, providing the player with a second probability of achieving the special-payout outcome, the second probability being greater than the first probability;	
conducting the basic game with the first probability if the player does not choose the side-wager option, or the second probability if the player chooses the side-wager option; and	Glavich does not teach conducting the basic game with different probabilities depending on the side wager because the side wager is made after an outcome of the basic game
in response to conducting, crediting the player the special payout when the special-payout outcome occurs in the basic game.	Glavich does not disclose a special-payout outcome, only an outcome giving the opportunity to play a bonus game. No payouts are guaranteed.

Claim Element	Glavich
12. A gaming terminal for playing a wagering game having a special payout with a first payout and a second payout, the gaming terminal comprising:	Glavich only describes a single payout for the wagering game, the bonus game is an outcome not a payout
a basic game having a randomly selected outcome being selected independently of player selection;	Glavich mandates that a player selects an outcome in the bonus game
a basic wager input accepting a basic wager from a player for the basic game on at least one of a plurality of paylines, the basic wager being between a minimum and maximum amount;	
the gaming terminal having two options for being eligible for the special payout, the two options including (i) an additional, separate side-wager input option for placing an additional side-wager distinct from the accepted basic wager, the side-wager option requiring a side-wager amount in addition to the accepted basic wager and (ii) a max-wager option for placing the basic wager at the maximum amount resulting in wagers on each of the plurality of paylines;	The bonus game in Glavich is not a special payout of the basic game. Even if the bonus game of Glavich constitutes a special payout of the basic game, the side-wager is offered only after the opportunity of the special game is awarded by the basic game which is the result of the basic wager. The side-wager and regular wager do not allow the same payout.
wherein, in response to selection of either of the two options, the gaming terminal awards the player the first payout when a first randomly selected outcome is achieved in the basic game and the gaming terminal awards the player the second payout when a second randomly selected outcome is achieved in the basic game; and	The bonus game in Glavich only allows a single outcome, the selection of player-selectable elements. There are not two outcomes resulting in the same payouts in the basic game in Glavich
wherein if neither of the two options is selected, the gaming terminal does not award the player the first payout when the first randomly selected outcome is achieved in the basic game and does not award the player the second payout when the second selected outcome is achieved in the basic game.	Not choosing the side wager option in Glavich does not change the probability of the occurrence of a basic game outcome since the bonus game will always be offered to the player achieving that outcome regardless of the wager

A. Claims 1, 10, 12, 25, 28 and 29 Require A Basic Game With A Random Outcome Selected Independently Of Player Selection

Claims 1, 10, 12, 25, 28 and 29 require that the randomly selected outcomes that include the special-payout outcome or progressive-payout outcome are “selected independently of player selection.” Glavich does not anticipate or render obvious this element as the player in Glavich directly selects the outcomes that include the special-payout option in the bonus game. Even if the outcomes of the bonus game are an outcome of the basic game as asserted by the Final Office Action (p. 2), the only payout outcome in the “bonus payout” outcome that requires player a player select one of the M elements with a payout associated with it. The special-payout outcome or progressive-payout outcome is randomly selected independently of player selection in amended claims 1, 10, 12, 25, 28 and 29.

The Final Office Action has asserted that the basic game has spinning slot reels and the picks of the bonus games are randomly selected by the gaming terminal (pp. 2-3) and therefore the outcomes are selected independently of player selection in Glavich. However, even this strained interpretation fails to meet the claim elements. Claims 1, 10 and 29 require “a plurality of randomly selected outcomes being selected independently of player selection” including a special-payout outcome or a progressive payout outcome. The outcomes of the bonus game that payout to a player all require player selection of the outcome. As will be explained below, if the bonus game itself is the special-payout outcome, other elements of the claims are not met.

B. Glavich Does Not Disclose A Basic Game With A Special Payout As Required By The Independent Claims; A Bonus Game Is Not A Special Payout

Claims 1, 10, 12, 25, 28 and 29 also all require a basic game. Glavich relates to a bonus game that allows a player to make a special wager to increase the chance of selecting an element in the bonus game. However, contrary to the assertions of the Final Office Action, the

probability of achieving a winning outcome by being awarded a bonus game is not a payout as defined by the present claims. First, there is no guarantee that the bonus game in Glavich will pay anything to a player. Glavich specifically notes that there are instances where the player selectable elements award nothing. (Col. 5, ll. 18-23). A payout is understood to mean a guaranteed return if the outcome is achieved. Achieving a play of the bonus game in Glavich does not guarantee any award value since a player may select elements that award nothing. Second, an outcome that does not directly award a value is not a payout as conventionally understood by one of ordinary skill in the art. The Final Office Action has offered no evidence that the outcome of an opportunity to play a bonus game falls under the definition of a “payout.” Third, Glavich makes a clear delineation between the main or basic game and the bonusing feature. Glavich states that:

In general, the main game 214 is distinguishable from a bonusing feature because there must be at least some amount of play of the main game, before initiating of the bonusing feature, and/or because the main game is the game which is most prominently featured or displayed on the gaming terminal and/or because the main game is the game on which the player wagers.

(Col. 3, ll. 36-42, emphasis added). It is clear that the play of the main game in Glavich is separate from the bonus game. Glavich also clearly defines the opportunity of playing a bonus game as a definite outcome of the basic game.

[T]he bonusing feature is initiated upon the occurrence of a bonus trigger event 216. If a bonus trigger event does not occur a procedure returns 218 to permit another wager and main game play if desired. In some embodiments, the bonus trigger 216 relates to outcomes or other aspects of the main game such as achieving certain main game results (e.g., achieving one or more bonus symbols 138 on a slot machine pay line 142, FIG. 1), play of a certain number of rounds of the main game, wagering of at least a threshold amount, accumulation of a threshold point, credit or prize amount in the main game and the like.

(Col. 3, ll. 43-53, emphasis added). Nowhere does Glavich support the assertion that the outcomes of the separate bonus feature are included in the outcomes of the basic game.

C. Glavich Does Not Conduct The Basic Game With Different Probabilities Based On Selection Of The Side-Wager Option As Required By Claims 1, 10 and 29

Claims 1, 10 and 29 require conducting the basic game with the first probability if the player does not choose the side-wager option, or the second probability if the player chooses the side-wager option. Glavich does not disclose this option because Glavich does not provide the player the option to make a side-wager option until after an outcome of the basic game is achieved. (Col. 3, l. 66- Col. 4, l. 2). The play of the basic game must be complete prior to initiating the bonus game. (Col. 3, ll. 36-41). Therefore, the probabilities of the basic game cannot be different because the side-wager option is offered after the basic game is conducted at a first probability in Glavich.

D. Claims 12, 25 and 28 Require Not Awarding Payouts When Outcomes Are Obtained; Glavich Always Awards Payouts When Outcomes Are Obtained

Claims 12, 25 and 28 require “if neither of the two options is selected, the gaming terminal does not award the player the first payout when the first randomly selected outcome is achieved in the basic game and does not award the player the second payout when the second selected outcome is achieved in the basic game.” Glavich does not teach this element. Even if the player does not wager the maximum or offer a side-wager, the outcome of a bonus game may still be achieved by the player in Glavich. (Col. 2, ll. 43-44). Further, even if the bonus game picks are considered “special-payout outcomes,” Glavich does not disclose this element. As the Final Office Action asserts, changing the number, M, of selectable outcomes associated with a favorable result only changes the probability of winning a prize, it does not change the existence

of the outcome. (pp. 2, 5). Thus, the outcome in Glavich is still available to be awarded to a player who does not max bet or provide a side wager.

The Final Office Action has asserted that it would be obvious to eliminate certain items such as bonus values, free plays when a max wager or side wager is not made. (pp. 7-8). Glavich does not disclose or suggest such a concept. Glavich only discloses varying the numbers of items (N), selections (Z), or number of items with prizes (M) based on a wager. Glavich is silent as to whether the types of prizes may be varied based on the wager type. In fact Glavich teaches the opposite, that any “associated item can include various prizes” and therefore there is no range of prizes that is excluded based on a player wager. (Col. 4, ll. 44-53).

E. Claims 3, 10 and 25 Require A Progressive Game Payout

Dependent claim 3 requires that a progressive payout is “contributed to by a plurality of gaming machines including a gaming machine playing the wagering game.” Claim 10 and 25 also require a progressive payout. Glavich does not disclose a progressive payout or such a payout that is contributed from a plurality of gaming machines. The Final Office Action cites Col. 4, ll. 44-52 for Glavich as disclosing that the items may include monetary prizes which “obviously includes a progressive payout.” (p. 7). The Final Office Action offers no rationale why monetary prizes encompass a progressive payout as required by claims 10 and 25. Even accepting this rationale, monetary prizes does not include a payout “contributed to by a plurality of gaming machines including a gaming machine playing the wagering game” as required by claim 3 because Glavich only discloses a single gaming machine. Claims 3, 10 and 25 are therefore independently allowable over Glavich.

Conclusion

It is Applicant's belief that all of the claims are now in condition for allowance and actions towards that effect is respectfully requested.

If there are any matters which may be resolved or clarified through a telephone interview, the Examiner is respectfully requested to contact the undersigned attorney at the number indicated.

Respectfully submitted,

Date: July 16, 2009

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